

Application No: 09/522,753
Filing Date: March 10, 2000
Response to Office Action (mailed December 14, 2005)
Page 6 of 8

Attorney Docket No: SALK 1510-3
(088802-8704)

REMARKS

The present invention relates to co-repressor polypeptides that are capable of mediating the transcriptional silencing of at least one member of the steroid/thyroid hormone superfamily of receptors. Exemplary members of the silencing mediators of retinoic acid and thyroid hormone receptors (SMRT) family of co-repressors are provided, including full length human SMRT co-repressors, as well as various isoforms of mouse and Drosophila SMRT co-repressors.

By the present communication, claims 14 and 16 have been amended to define Applicants' invention with greater particularity. No new matter is introduced by the subject amendments as the amended claim language is fully supported by the disclosure and the original claims. In addition, claims 9, 10, 12, 13, 17 and 38 are cancelled herein without prejudice as drawn to non-elected subject matter. Accordingly, claims 3-5, 14, 16, and 18-25 are now pending. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination, is presented in the Listing of Claims, beginning on page 2 of this communication, with an appropriate status identifier for each claim.

The restriction of claims 3-5, 9, 10, 12-14, 16-25 and 38 under 35 U.S.C. § 121, as allegedly being drawn to three distinct inventions, is respectfully traversed. It is respectfully submitted that all of the claims are interrelated such that a prior art search of one group would uncover art of potential relevance to the other groups.

It is respectfully submitted that all of the claims are highly related; each of the claims is directed to polynucleotides encoding proteins that are structurally and functionally similar. Indeed, all of the claims are directed to nucleic acids encoding members of a defined family of receptor interacting co-repressors (i.e., SMRT co-repressors). Further, all such encoded SMRT co-repressors have the same function, that is, transcriptional silencing of members of the steroid/thyroid hormone receptor superfamily. Thus, given the common features of all nucleic acids (and the proteins encoded thereby) embraced by the present claims, it is respectfully

DLMR_279660.2

Application No: 09/522,753
Filing Date: March 10, 2000
Response to Office Action (mailed December 14, 2005)
Page 7 of 8

Attorney Docket No: SALK 1510-3
(088802-8704)

submitted that no undue burden is placed on the Examiner to search all aspects of the initially claimed invention in one case.

It is further submitted that the MPEP provides for the search of 10 sequences without restriction. As stated in the MPEP at Section 803.04,

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction.

The present claims are drawn to three nucleic acid sequences (SEQ ID NO:4, SEQ ID NO:6, SEQ ID NO:8), well below the ten sequence maximum allowed in the MPEP. Accordingly, reconsideration and withdrawal of the restriction requirement are respectfully requested.

However, in order to be fully responsive, Applicants elect the Group I claims (i.e., claims 3-5, 14, 16, and 18-25) with traverse.

DLMR_279660.2

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Filing Date: March 10, 2000
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Page 8 of 8

Attorney Docket No: SALK 1510-3
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CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that the present application is now in condition for allowance. Accordingly, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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DLMR_279660.2